Supreme Court, U.S.

No. 92-1576

In The

Supreme Court of the United States

October Term, 1992

ROBERT M. SINSKEY,

Petitioner,

v.

PHARMACIA OPTHALMICS, INC.,

Respondent.

Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

Whether under Fed. R. Civ. P. 56(c), and the Supreme Court cases interpreting that rule, summary judgment of patent invalidity under 35 U.S.C. § 102(b) is properly granted when *prima facie* and undisputed showings of on-sale and public-use bars have been made, all objective evidence points away from any experimental use of the invention claimed by the patent-in-suit, and the only evidence showing an experimental purpose is the inventor's subjective intent as stated in a declaration made subsequent to and in direct conflict with the inventor's earlier deposition testimony.

LIST OF PARTIES

(SUPREME COURT RULE 29.1)

Pursuant to Supreme Court Rule 29.1, the following is a list of all parent companies and subsidiaries (except wholly-owned subsidiaries) of Respondent Pharmacia Opthalmics, Inc.:

Procordia A.B.

Kabi Pharmacia A.B.

Volvo

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STATEMENT OF THE CASE

Respondent Pharmacia Opthalmics, Inc. ("Pharmacia") incorporates herein by reference the background section contained in the Federal Circuit decision reported at 982 F.2d 494, 25 U.S.P.Q.2d 1290 (Fed. Cir. 1992) and reproduced in the Appendix section of Petitioner Sinskey's Petition for Writ of Certiorari at A 1-12.

REASONS FOR DENYING THE WRIT

The decision of the Court of Appeals for the Federal Circuit affirming the trial court's grant of summary judgment in favor of Pharmacia contains nothing that supports this Court's exercise of its discretion to grant a writ of certiorari: the Federal Circuit's decision is not in conflict with the decisions of any other federal appellate courts, and is totally consistent with the decisions of those courts; no important question of law is raised by the decision, and; the Federal Circuit's decision is not only correct but is fully supported by prior case law. For these reasons, which are explained more fully hereinbelow, Sinskey's petition for a writ of certiorari should be denied.

I. THE CIRCUIT COURTS ARE IN COMPLETE AGREEMENT THAT A GENUINE ISSUE OF MATERIAL FACT IS NOT RAISED WHEN A PARTY CONTRADICTS, WITHOUT SATISFACTORY EXPLANATION, HIS OR HER PRIOR TESTIMONY

Whenever they have considered the question, the courts of appeals have uniformally agreed that no

genuine issue of material fact is raised when, without satisfactory explanation, a party contradicts his or her prior testimony. *See, e.g., Martin v. Merrell Dow Pharmaceuticals, Inc.*, 851 F.2d 703 (3d Cir. 1988); *Franks v. Nimmo*, 796 F.2d 1230 (10th Cir. 1986); *Miller v. A. H. Robins Co.*, 766 F.2d 1102 (7th Cir. 1985); *Van T. Junkins & Assocs. v. United States Indus.*, 736 F.2d 656 (11th Cir. 1984); *Camfield Tires, Inc. v. Michelin Tire Corp.*, 719 F.2d 1361 (8th Cir. 1983); *Radobenko v. Automated Equip. Corp.*, 520 F.2d 540 (9th Cir. 1975); *Perma Research & Dev. Corp. v. Singer Co.*, 410 F.2d 572 (2d Cir. 1969).

The rationale behind these decisions is quite simple: the objective sought by the summary judgment rule "would be seriously impaired if the district court were not free to disregard the conflicting [declaration]." *Martin v. Merrell Dow*, 851 F.2d at 706.

In the present case, the Federal Circuit expressly upheld the district court's finding that the assertions in Sinskey's declaration regarding the alleged experimental purpose behind his first eleven intraocular lens (IOL) implantations "directly conflict with [his] deposition statements that he did not believe the lens required testing." (A 7.)[1] Moreover, the Federal Circuit stated that "[t]here is no explanation for the facial inconsistency, and the declaration does not attempt to reconcile the conflict; indeed, it does not address Sinskey's deposition testimony at all." (A 7.) Under such circumstances, and given the uniform position of the circuit courts on this issue, the

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[1] Unless otherwise stated, appendix references are to the appendix appearing at the end of Sinskey's Petition for Writ of Certiorari.

Federal Circuit was obviously justified in holding that Sinskey had failed to meet his burden of showing the existence of a genuine issue of material fact. To hold otherwise would, as the Federal Circuit stated "allow [Sinskey] to preclude summary judgment simply by contradicting his own prior statements." (A 8.)

Nothing in the Federal Circuit's decision is in conflict with the decisions of other circuits that have addressed this issue. Moreover, no case cited by Sinskey demonstrates that such a conflict exists.

Specifically, *Kennett-Murray Corp. v. Bone*, 622 F.2d 887 (5th Cir. 1980), the principle case relied on by Sinskey, expressly recognizes the long line of cases in which conflicting testimony was not held to raise a genuine issue of fact sufficient to preclude summary judgment. *See* 622 F.2d at 893-94. Nowhere does the *Kennett-Murray* court disagree with the conclusions or analyses of these cases; it simply states that "the concerns raised in [such cases] are not present in this case." *Id.* at 895. This is not surprising since explanations for the inconsistent testimony were proffered in *Kennett-Murray* and the court spent considerable time analyzing these explanations. Thus, *Kennett-Murray* is easily distinguishable from cases, such as the present one, where no satisfactory explanation for a party's contradictory testimony is offered.

The case of *Dibidale of Louisiana, Inc. v. American Bank & Trust Co.*, 916 F.2d 300 (5th Cir. 1990), the only other case cited by Sinskey, is similarly distinguishable. Indeed, in *Dibidale* the court went so far as to find that the alleged

disparate testimony, when viewed in a light most favorable to the non-moving party, was not inherently inconsistent at all. *Id.* at 307. This finding clearly separates *Dibidale* from cases where no explanation for a party's inconsistent testimony is presented.

The circuit court decisions are completely uniform in holding that a party's subsequent declaration does not create a genuine issue of material fact when it contradicts, without satisfactory explanation, the party's prior testimony. No case cited in Sinskey's petition is contrary to this well-established rule. Thus, Sinskey has failed to demonstrate that his petition should be granted on grounds that a conflict exists in the circuit courts.

II. THE FEDERAL CIRCUIT'S DECISION PRESENTS NO IMPORTANT QUESTION OF LAW FOR THIS COURT TO CONSIDER

In his petition, Sinskey mischaracterizes the Federal Circuit's decision in an attempt to create the impression that an important question of law, requiring the attention of this Court, has been raised by the Federal Circuit's opinion. Specifically, Sinskey states that "the Appeals Court authorized a general rule that non-contemporaneous evidence of experimental use could never withstand a summary judgment motion." Petition at 9. Sinskey then argues that, in applying this "general rule," the Federal Circuit took it upon itself to ignore certain testimony, thereby violating fundamental principles applicable to summary judgment proceedings laid down by this Court. Petition at 9-10. However, and contrary to Sinskey's assertions, no such "general rule" was adopted by the

Federal Circuit. Thus, Sinskey's argument is without merit and he has failed to establish that an important question of law is presented for this Court's review.

Specifically, in analyzing the question of whether Sinskey had adequately raised a genuine issue of material fact concerning the alleged experimental purpose associated with his pre-critical date IOL implantations, the Federal Circuit reviewed the law relating to experimental use. First, the court pointed out that "[t]o establish that an otherwise public use or sale does not run afoul of section 102(b), it must be shown that the activity was 'substantially for purposes of experiment.'" (A 9, *quoting Baker Oil Tools, Inc. v. Geo Vann, Inc.*, 828 F.2d 1558, 1564, 4 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1987).) The Court then noted that some objective evidence must be presented in order to support a showing of experimental use. (A 9.) Finally, the court made the following statement with regard to the evidence Sinskey had presented in support of his claim of experimental use:

> Post-hoc affidavit testimony alone, years after the events described and purporting to show an inventor's subjective experimental intent, will never satisfy the burden of establishing experimental use *in a case like this* where there is no contemporaneous evidence of experimental purpose and the objective evidence is to the contrary. (A 10, emphasis added.)

This statement makes it clear that, notwithstanding Sinskey's assertions to the contrary, the Federal Circuit did not adopt a "general rule that non-contemporaneous evidence of experimental use could never withstand a summary judgment motion." Rather, the Federal Circuit

articulated a narrow rule tailored to the facts of this case. The Federal Circuit stated that where there is no contemporaneous evidence of experimental purpose and the objective evidence is to the contrary, mere affidavit testimony presented years after the events described could not satisfy the burden of establishing experimental use.

This narrowly tailored rule is a far cry from the "general rule" Sinskey claims was laid down by the Federal Circuit. More importantly, this rule is completely consistent with the Federal Circuit's prior decisions on this point, *see, e.g., Harrington Mfg. Co. v. Powell Mfg. Co.*, 815 F.2d 1478, 1481 n.3, 2 U.S.P.Q.2d 1364, 1366 n.3 (Fed. Cir. 1986), and presents no important question of law or departure from existing law requiring this Court's review.

III. THE FEDERAL CIRCUIT'S DECISION COMPORTS FULLY WITH ITS HOLDINGS IN PRIOR "EXPERIMENTAL USE" CASES AND IS FULLY SUPPORTED BY THE FACTS AND CIRCUMSTANCES SURROUNDING THIS CASE

The final argument in Sinskey's petition is that the Federal Circuit's decision constitutes a failure to follow the established case law in experimental use cases and should therefore be reviewed by this Court. This argument is completely without merit.

Although Sinskey correctly sets forth the law associated with experimental use, he completely fails to demonstrate that that law was incorrectly applied in this case.

More particularly, Sinskey sets forth the factors to be examined in determining whether a use was experimental. These factors include:

> [T]he necessity for public testing, the amount of control retained over the operation, the extent of public testing in relation to the nature of the invention, the length of the test period, whether any payment was made, whether there was a secrecy obligation, whether progress records were kept, who conducted the experiments, and the degree of commercial exploitation during the tests in relation to the purpose of the experimentation.

Baker Oil Tools, 828 F.2d at 1564, 4 U.S.P.Q.2d at 1214 (citations omitted). No single factor in the experimental use analysis is dispositive, and a determination on the issue should only be made after considering the entire surrounding circumstances. *T. P. Laboratories v. Professional Positioners, Inc.*, 724 F.2d 965, 971, 220 U.S.P.Q. 577, 582 (Fed. Cir. 1984).

Notwithstanding these considerations, Sinskey argues that, because there is a facial similarity between the facts in *T. P. Laboratories* and the present case, the Federal Circuit's decision in this case is inconsistent with its decision in *T. P. Laboratories* where the court found that certain conduct was experimental in nature and did not give rise to a public use bar to patentability. However, Sinskey's argument is fatally flawed in that, under the "totality of the circumstances" approach mandated by *T. P. Laboratories*, he has completely failed to come forward with objective evidence sufficient to overcome summary judgment.

Indeed, as the Federal Circuit noted, "[t]he objective evidence in this case cuts heavily against experimental

use." (A 10.) The Federal Circuit succinctly summarized this objective evidence as follows:

> Sinskey charged his usual surgical fee of $1,900 for each of the eight operations and IOLAB charged its standard $250 price for the lenses. He did not inform the patients that they were being treated with a "new" or "experimental" lens, nor did he obtain any kind of secrecy agreement from the patients or surgical staff. None of the documents provided by IOLAB or Sinskey ever referred to the Model 103J as "experimental" or the subject of tests. Apparently, routine medical records of these implantations were kept, but Sinskey does not refer to them specifically, and they were not put before the district court. If they contained any indication that the implantations were part of an experimental or test program, rather than routine operations, it is fair to assume Sinskey would have offered them. Besides, in its Premarket Approval Application to the FDA, IOLAB characterized the Sinskey lens as "equivalent in design, use and function to the Shearing . . . Lenses" and requested that it be "approved at this time as a supplement to the Shearing" lenses. (A 10-11.)

The Federal Circuit went on to point out that Sinskey presented no evidence, subjective or otherwise, contemporaneous with his initial implant operations that would corroborate his claims that these operations were for experimental purposes. (A 11.)

Based on the existing objective evidence and Sinskey's lack of evidence to the contrary, the Federal Circuit affirmed the trial court's determination that, within the

context of demonstrating an experimental use, Sinskey had failed to raise a genuine issue of material fact and thereby avoid summary judgment.

Nothing in Sinskey's petition demonstrates that the Federal Circuit failed to follow prior applicable case law or that the court's analysis in this case was somehow faulty. All that Sinskey argues is that "[t]he facts in *T. P. Laboratories*, [are] remarkably similar to the facts in this action," and, since this action was decided differently than *T. P. Laboratories* the Federal Circuit must be wrong. However, an examination of the facts in *T. P. Laboratories*, within the context of the factors to be considered in an experimental use analysis, shows that *T.P. Laboratories* is easily distinguishable from the present case.

First, although it is correct to say that both the inventor in *T. P. Laboratories* and Sinskey lacked secrecy agreements with their patients, there ends any similarity between the two cases. In *T. P. Laboratories*, the invention involved orthodontic devices which were labeled "experimental." 724 F.2d at 967, 220 U.S.P.Q. at 579. Sinskey has produced no evidence that the lenses he implanted prior to the critical date were designated "experimental." Further, IOLAB's November 16, 1979 Engineering Change Notice states that the Model 103J "has been added to our existing models." (Appeals Court Appendix at 436.) There is no indication on the document that the lens was in any way experimental.

Also, the nature of the invention in *T. P. Laboratories*, i.e., orthodontic devices requiring long periods of monitoring to determine if they were working properly, is dramatically different from the nature of Sinskey's

device. As Sinskey testified, the only test he needed to make was to determine how easy the lens was to implant. (Appeals Court Appendix at 404.) This determination was immediately made during the first implant procedure.

Finally, in *T. P. Laboratories*, the product's inventor was also its manufacturer, and even though the inventor/manufacturer could have sold the orthodontic devices during the experimentation period, it elected not to offer the devices for sale. *Id.* at 972-73, 220 U.S.P.Q. at 583. In contrast, Sinskey's licensee, IOLAB, sold at least three Model 103J lenses prior to the critical date.

Thus, *T. P. Laboratories* is easily factually distinguishable from the present case and Sinskey's reliance on *T. P. Laboratories*, to show that the Federal Circuit's decision in this case is not in accord with its previous holdings in experimental use cases, is misplaced.

CONCLUSION

For each of the foregoing reasons, a writ of certiorari should be denied.

Dated: April 27, 1993

Respectfully submitted,

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